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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/701,634 12/01/00 MIYAZAWA

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EXAMINER

IM52/0628

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MARKHAM, W

ART UNIT

PAPER NUMBER

1762

DATE MAILED:

06/28/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trad marks

Office Action Summary	Application No. 09/701,634	Applicant(s) MIYAZAWA, MAKOTO	
	Examiner Wesley D Markham	Art Unit 1762	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on _____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 December 2000 is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- | | |
|---------------------------------------------------------------------------------------------------------------|------------------------------------------------------------------------------|
| 15) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 18) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 16) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 19) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 17) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>1</u> . | 20) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Drawings

1. Figure 5 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g).

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 3 and 8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
4. Specifically, the phrase "said edging mark is an edging line forming a shape slightly larger than and similar to a peripheral edge shape of a edged lens" in Claims 3 and 8 is a relative phrase which renders the claims indefinite. The phrase "said edging mark is an edging line forming a shape slightly larger than and similar to a peripheral edge shape of a edged lens" is not defined by the claims, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. For example, it is unclear what range of sizes is encompassed by "slightly larger than" and what range/variation in shapes is encompassed by "similar to."

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1 and 4 – 5 are rejected under 35 U.S.C. 102(b) as being anticipated by Kato (JP 09-99444 A).

7. Regarding Claim 1, Kato teaches a method for producing a spectacle lens comprising a marking step of depicting production information of the spectacle lens in a region of a surface of the spectacle lens to be cut off by edging. Specifically, Kato teaches carving reference marks in the unfinished lens's outer periphery to be cut off by edging (Solution and Figure 1).

8. Kato teaches all the limitations of Claim 4 as set forth in paragraph 7, including a method wherein the production information includes reference position marks indicating the vertical direction of the spectacle lens (Solution and Figure 1).

9. Kato teaches all the limitations of Claim 5 as set forth in paragraph 7, including a method further comprising an edging step. Specifically, Kato teaches that the lens is cut to a predetermined diameter, and the reference marks are cut off (i.e., the lens is edged) and are not present at the time of lens delivery (Solution).

10. Claims 6 and 9 are rejected under 35 U.S.C. 102(a) as being anticipated by Yasushi et al. (JP 10-282459 A).

11. Regarding Claim 6, Yasushi et al. teach a lens processing system comprising a reference position detecting apparatus for detecting a reference position of a spectacle lens, and a marking apparatus for depicting production information of the spectacle lens on a surface of the spectacle lens on the basis of reference position information obtained by the reference position detecting apparatus. Specifically, Yasushi et al. teach a positioning unit (e.g., a reference position detecting apparatus) that detects the hidden marks on a lens (e.g., the reference position). The lens is then positioned using this reference position, and auxiliary marks (e.g., production information) are printed on the lens using a printing station (Abstract and Figure 11).

12. Yasushi et al. teach all the limitations of Claim 9 as set forth in paragraph 11, including a lens processing system wherein the production information includes reference position marks indicating the vertical direction of the spectacle lens (Abstract and Figure 11, reference number (75)).

Claim Rejections - 35 USC § 103

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kato (JP 09-99444 A) in view of Logan et al. (USPN 4,711,035).

15. Kato teaches all the limitations of Claim 2 as set forth in paragraph 7 above, except a method wherein the production information includes an edging mark indicating a region of the lens remaining after edging. However, Logan et al. teach that, in general, the shape of the lens opening is transferred to the surface of a lens blank by a marker or other transfer device (e.g., and edging line is provided), and then the lens blank is cut following the outline (Col.1, lines 24 – 30). As it is the intention of Kato to cut the unfinished lens to a desired shape and size, it would have been obvious to one of ordinary skill in the art to provide an edging line as taught by Logan et al. on the surface of the unfinished lens of Kato with the reasonable expectation of successfully marking the lens for further processing such as edging/cutting as desired by Kato.

16. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kato (JP 09-99444 A) in view of Logan et al. (USPN 4,711,035) in further view of Wood et al. (USPN 5,053,971).

17. Kato and Logan et al. teach all the limitations of Claim 3 as set forth in paragraphs 7 and 15 above, except a method wherein the edging line is slightly larger than a peripheral edge shape of an edged lens. Specifically, Logan et al. teach that the edging line follows the periphery of the desired lens shape without explicitly teaching that the edging line is slightly larger than the peripheral edge shape of an edged lens (Col.1, lines 24 – 30). However, Wood et al. teach that, in surface mapping the

periphery of a lens to be edged, it is desirable to trace the periphery at a 0.02" greater radius than the desired finished lens edge (Col.7, lines 45 – 47, Col.8, lines 1 – 5, and Figure 5). Wood et al. teach that mapping at a greater radius than the finished edge dimension avoids creating scratches on the lens surface (Col.8, lines 3 – 5). Therefore, it would have been obvious to one of ordinary skill in the art to form the edging line of Kato and Logan et al. at a radius slightly larger than the desired finished edge radius of the lens with the reasonable expectation of minimizing markings/damages on the finished surface of the lens as taught by Wood et al.

18. Claims 6 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hoya Corp. (JP 2507643 Y2) in view of Yasushi et al. (JP 10-282459 A).

19. Regarding Claim 6, Hoya Corp. teaches an unfinished spectacle lens having both reference marks and hidden marks without explicitly teaching how the reference marks are added to the lens. In the lens of Hoya Corp., the reference marks are located outside the desired finished diameter of the lens (Figure 2, reference numbers (3) – (6)). Yasushi et al. teach a method of successfully detecting the hidden marks on a spectacle lens and providing reference marks on the lens in response to the position of the hidden marks (Abstract and Figure 11). Therefore, it would have been obvious to one of ordinary skill in the art to provide the reference markings of Hoya Corp. using the lens processing system of Yasushi et al. with the reasonable expectation of successfully providing reference markings on the surface of the lens of Hoya Corp. in response to the hidden markings on the lens of Hoya Corp.

20. Hoya Corp. and Yasushi et al. teach all the limitations of Claim 9 as set forth in paragraph 19, including a system wherein the production information includes reference position marks indicating the vertical position of the spectacle lens (Figures 1 and 2 of Hoya Corp. and Figure 11 of Yasushi et al.).

21. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hoya Corp. (JP 2507643 Y2) in view of Yasushi et al. (JP 10-282459 A) in further view of Logan et al. (USPN 4,711,035).

22. Hoya Corp. and Yasushi et al. teach all the limitations of Claim 7 as set forth in paragraph 19, except a system wherein the production information includes an edging mark indicating a region of the lens remaining after edging. However, Logan et al. teach that, in general, the shape of the lens opening is transferred to the surface of a lens blank by a marker or other transfer device (e.g., an edging line is provided), and then the lens blank is cut following the outline (Col.1, lines 24 – 30). As it is the clear intention of Hoya Corp. to further edge the unfinished lens to a desired shape (Figure 2, reference number (8), and Col.6, lines 1 – 9 as verified by a USPTO oral translation), it would have been obvious to one of ordinary skill in the art to provide an edging line as taught by Logan et al. on the surface of the unfinished lens of Hoya Corp. with the reasonable expectation of successfully marking the lens for further processing such as edging/cutting as desired by Hoya Corp.

23. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hoya Corp. (JP 2507643 Y2) in view of Yasushi et al. (JP 10-282459 A) in further view of Logan et al. (USPN 4,711,035) in further view of Wood et al. (USPN 5,053,971).

24. Hoya Corp., Yasushi et al., and Logan et al. teach all the limitations of Claim 8 as set forth in paragraph 22, except a system wherein the edging line is slightly larger than the peripheral edge shape of an edged lens. However, Wood et al. teach that, in surface mapping the periphery of a lens to be edged, it is desirable to trace the periphery at a 0.02" greater radius than the desired finished lens edge (Col.7, lines 45 – 47, Col.8, lines 1 – 5, and Figure 5). Wood et al. teach that mapping at a greater radius than the finished edge dimension avoids creating scratches on the lens surface (Col.8, lines 3 – 5). Therefore, it would have been obvious to one of ordinary skill in the art to use a system that forms the edging line of Hoya Corp., Yasushi et al., and Logan et al. at a radius slightly larger than the desired finished edge radius of the lens with the reasonable expectation of minimizing markings/damages on the finished surface of the lens as taught by Wood et al.

25. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hoya Corp. (JP 2507643 Y2) in view of Yasushi et al. (JP 10-282459 A) in further view of Logan et al. (USPN 4,711,035) in further view of Komatsu et al. (JP 06-191159 A).

26. Hoya Corp., Yasushi et al., and Logan et al. teach all the limitations of Claim 10 as set forth in paragraph 19, except a system wherein the marking apparatus includes a laser irradiation apparatus for irradiating the spectacle lens with a laser beam. However,

Komatsu et al. teach an apparatus that provides laser marking(s) on the surface of a lens (Constitution). Komatsu et al. teach that this apparatus performs the marking operation simply, and that the laser beams can be adjusted easily (Purpose). Therefore, it would have been obvious to one of ordinary skill in the art to incorporate the laser marking apparatus of Komatsu et al. into the marking apparatus of Hoya Corp., Yasushi et al., and Logan et al., with the reasonable expectation of successfully providing reference and edging markings on the lens of Hoya Corp., Yasushi et al., and Logan et al. simply and easily with a laser marking device as taught by Komatsu et al.

Conclusion


27. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Wesley D Markham whose telephone number is (703) 308-7557. The examiner can normally be reached on Monday - Friday, 7:30 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Shrive Beck can be reached on (703) 308-2333. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-5408 for regular communications and (703) 305-3599 for After Final communications.


Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

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WDM
June 27, 2001

Wesley D Markham
Examiner
Art Unit 1762


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